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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,748	10/20/2003	Abe Nishiki		9269

7590 08/13/2010
Clyde I. Coughenour
16607 Sutton Place
Woodbridge, VA 22191

EXAMINER

BLATT, ERIC D

ART UNIT	PAPER NUMBER
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3734

MAIL DATE	DELIVERY MODE
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08/13/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

- 6) In response to the Appeal Brief of December 22, 2008, on June 8, 2010, the examiner re-opened prosecution and issued a non-final Office action with new grounds of rejection.
- 7) On August 4, 2010, the applicant filed third appeal brief appealing the rejected claims.
- 8) On August 4, 2010 the present petition was filed requesting the examiner to Allow the application or write an examiner's answer and forward the case to the Board of Patent Appeals and Interferences for its adjudication.

Discussion and Analysis

A review of the application reveals that there is a prolonged prosecution in this case. The application history also shows the examiner reopened prosecution two times. Office policy requires examiners to complete a thorough prior art search, and avoid piecemeal examination as much as possible. Office policy discourages piece meal prosecution as set forth in M.P.E.P. §707.07(g)¹. Regrettably due to late discovery and different interpretation of the prior art references, prosecution of the applicant's invention has been unavoidably prolonged. It should be noted that the Primary Examiner has a duty to consider the merits of the claims under M.P.E.P. § 1004. In order to avoid re-opening prosecution, the examiner is again reminded to perform a complete and thorough search of prior art considering not only the claims presented, but also any subject matter the examiner reasonably anticipates might be incorporated into a subsequent amendment in accordance with M.P.E.P. 904.03².

In response to the petition, the examiner is hereby instructed to timely set up an appeal conference in accordance with M.P.E.P. §1207.01. Additionally, the examiner is also directed to conclude the examination of the application within three months or sooner from the filing date of the latest appeal brief.

In the petition, petitioner also request the drawing objection under 37 CFR 1.83(a) be withdrawn. A review of the record indicates that the drawing objection and claim rejection are directed at the same issues. Under 37 CFR 1.83(a)³, the drawing in a nonprovisional application must illustrate every claimed feature, with the exception of conventional features deemed not essential for a proper understanding of the invention. These features should be illustrated in a graphical drawing or labeled representation. In the non-final office action of June 8, 2010, the examiner stated "the drawings must show every feature of the invention specified in the claims. Therefore,

¹ M.P.E.P. § 707.07(g) states: Piecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available, avoiding, however, undue multiplication of references

² M.P.E.P. § 904.03 states in relevant part: "It is normally not enough that references be selected to meet only the terms of the claims alone, especially if only broad claims are presented; but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment."

³ § 1.83 Content of drawing. (a) The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box). In addition, tables and sequence listings that are included in the specification are, except for applications filed under 35 U.S.C. 371, not permitted to be included in the drawings.

the pawl being attached to the second handle grip by a second pivot pin must be shown or the feature(s) canceled from the claim(s)." In addition, the examiner also rejected at least claim 3 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The examiner stated "The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention." The examiner further explained the rejection⁴ of claim 3 in details on page 4 of the Office action mailed on June 8, 2010.

It is the policy of the USPTO in appropriate circumstances to decline to rule on a petitionable issue, when, as here, that an issue is also determinative of a rejection, and as such, is appropriate for consideration on appeal to the BPAI. In this case, the issue in the objection and rejection, as here, additionally and necessarily requires the exercise of technical skill and legal judgment in order to evaluate the facts presented, the issue is properly decided on the merits, and is properly reviewed on appeal, not petition. Under the circumstances, it is believed that the issues presented under the claim rejections and drawing objection in the instant case require the same review by the BPAI. Thus, the decision by the BPAI will be critical in determining whether or not the drawings should be accepted and entered. This petition to request withdrawal of drawing objection is dismissed and deferred to the BPAI as the issue as a whole is appealable and should not be decided by petition.

Conclusion

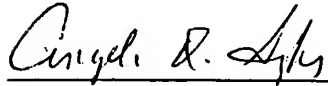
Under the circumstances, the relief requested to conclude the examination of the application is granted. For the reasons as stated above, the relief requested by the petitioner to withdraw the drawing objection will not be granted. Because there were objections to the drawings under 37 CFR 1.83(a) and a rejection of at least claim 3 under 35 USC 112, the overall issue is appealable and the drawing objection will not be decided by petition.

The application is being forwarded to the examiner via the Supervisory Patent Examiner of Art Unit 3734 for preparation of an Appeal Conference and examiner's answer. Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR

⁴ Claim 3 recites that the curved rack is attached to the first handle grip by a first pivot pin and the pawl is attached to the second handle grip by a second pivot pin. This second pivot pin is not shown in the drawings, and is mentioned only once in the specification in Paragraph 29 of the associated pre-grant publication 2004/0098003. This passage reads, "Ratchet mechanism 6 is equipped with a pawl 7, pivotally held by a second pivot pin on one handle grip 2R, and a rack 8, attached to the other handle grip." One skilled in the art would not understand from this disclosure how to use the second pivot pin. The specification explains that the rack and pawl are selectively engaged and disengaged with one another by rotating the rack about the first pivot pin, but the specification fails to address any application wherein the pawl is rotated about its pivot pin. Furthermore, pivotally mounting the pawl would seemingly allow the pawl to freely pivot out of engagement with the rack, thereby preventing proper function of the ratchet as disclosed. No means for preventing the pawl from freely pivoting out of engagement with the rack is disclosed. One skilled in the art would not understand from this disclosure how to properly operate this a ratchet wherein both the rack and pawl are pivotally mounted and no means for preventing the pawl from pivoting out of engagement with the rack is disclosed.

1.181". Any inquiry regarding this decision should be directed to Henry C. Yuen, Special Programs Examiner, at (571) 272-3468.

Petition Granted in part.



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